REMARKS

The Final Office Action of March 24, 2009 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Applicants submit, above, proposed amendments that are believed to overcome the new rejections under 35 USC §112, second paragraph. As the amendments overcome a rejection, and either place the claims in condition for allowance or reduce the matters for an appeal, and they are not believed to require a further search, Applicants respectfully request that the amendments be entered. The proposed amendments were not earlier submitted as this is a new rejection. The Examiner's confirmation of entry of the amendments is respectfully requested.

Traversal of Requirement for Restriction and Withdrawal of Claim 32

Applicants respectfully traverse the Examiner's restrictions of the claims presented and withdrawal of claim 32. As the basis for a restriction, the Examiner urges that the device as claimed can be used in a materially different process, and suggests that disinfecting surgical instruments such as catheters and endoscopes is materially different.

In response Applicants respectfully urge that the "device" referred to is a device for disinfecting operatory unit water and lines as recited in claim 1. The method of claim 32 is directed to disinfecting water and lines for medical use. Applicants fail to appreciate just what the Examiner relies upon as the basis for the conclusion that the device can be used for a materially different process. In the event the restriction is maintained, Applicants respectfully request that the Examiner establish how the claimed device could be used as alleged by the Examiner. Absent such a showing, restriction is improper and the requirement and withdrawal of claim 32 should be reversed.

Finality of the Office Action is Premature

Applicants further submit that the finality of the instant office action is premature as it is the first time that the Examiner has addressed the noted failure of the prior office action to set forth specific rejections of claims 18 and 22. While the Examiner may be correct in noting that the prior rejection referred to Contreras, this does not give rise to identifying where the "pump for withdrawing liquid containing dissolved ozone

from the ozone mixing system recirculates the liquid under pressure through a loop that conducts the liquid back to the ozone mixing system," as recited in claim 18. Nor does the Examiner make any indication that the limitation of a porous hydrophobic barrier preventing liquid from entering the ozone generator, as recited in claim 22, was addressed in the Sept. 2008 office action. Absent specific attention to the limitations of claims 18 and 22, the office action of September. 2008 was incomplete, and the current office action cannot be made final as this is Applicants first opportunity to address actual rejections of claims 18 and 22. Accordingly, Applicants request withdrawal of the finality and full consideration of the current response and entry, by right, of the proposed amendments.

Furthermore, Applicants note that with respect to the rejections set forth in the instant office action, while claims are again listed as being rejected under 35 USC §103, no specific application of the cited references has been applied for several of the dependent claims. Nor has the Examiner indicated that such claims are rejected in conjunction with other claims. Accordingly, the instant office action is again incomplete, on its face, and does not set forth rejections for all remaining claims as has been alleged. As an example, claim 7, while indicated as rejected based upon combinations of Contreras and Burris '993 as well as Engelhard and Burris '993, is not expressly discussed in either of the rejections. Just what basis are Applicants to consider relative to the rejection of dependent claims such as claim 7? Absent a specific teaching of elements of the dependent claims (e.g., a positive pressure pump of claim 7), there can be no *prima facie* obviousness to which Applicants must respond. [1] As a result, Applicants once again submit that the rejections are incomplete on their face and, therefore, the finality of the instant action is premature.

Summary of Rejections

Turning now to the Office Action, claims 33 and 34 were rejected under 35 USC §112, second paragraph, as being indefinite.

Claims 1-3, 5, 7–18, 20-31 and 33-34 were rejected under 35 USC §103(a) as being unpatentable over Contreras, US 5,824,243 ("Contreras") in view of Burris, US 5,207,993 ("Burris '993"). Claim 1 was rejected under 35 USC §103(a) as being

[1] MPEP2142 states that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

unpatentable over Burris '993 in view Contreras. Claims 1-3, 5, 7-16, 18, 20-29, 31 and 33-34 were rejected under 35 USC §103(a) as being unpatentable over Engelhard et al., US 5,942,125 ("Engelhard") in view of Burris '993.

35 USC §112, Second Paragraph, Rejection Traversed

In view of the amendments proposed above relative to claims 33 and 34, Applicants respectfully submit that claims 33 and 34, rejected under 35 USC §112, second paragraph, as being indefinite, nor particularly point out and distinctly claim the subject matter regarded as the invention. The objections raised by the Examiner to the claim language are believed to have been addressed in full and Applicants respectfully request that the rejection be withdrawn.

35 USC §103 Rejections Traversed

In order to establish *prima facie* obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 1074 (Fed. Cir. 1988). The rejection of claims 1-3, 5, 7–18, 20-31 and 33-34 under 35 USC §103(a) as being unpatentable over Contreras in view of Burris '993 is respectfully traversed.

Considering the rejection of claims 1-3, 5, 7–18, 20-31 and 33-34, Applicants submit that the suggested combination fails to support all the limitations recited in amended claims 1 or 30. Among other limitations, Applicants respectfully urge that Contreras and Burris '993, both alone and in combination, fail to teach the circulation system including a pressure regulator to maintain positive pressure in the circulation passageway. The Examiner appears to assert that the pump 10 of Contreras accomplishes such a function. However, it is unclear from Contreras how positive pressure is maintained in the circulation passageway.

Furthermore, neither Contreras nor Burris '993, alone or in combination, teach a control system including an ozone sensor located in the pressurized liquid circulation passageway, and an alarm to indicate whether the device is operating properly (e.g., claim 1). The Examiner continues to allege such limitations are taught by Burris '993, however, Burris '993 is not understood to include a pressurized liquid circulation passageway, let alone one that includes an ozone sensor. The Examiner is

reminded that all claim limitations must be considered in judging the patentability of the claim. (MPEP 2143.03; *citing In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970))

In light of the prior amendments to claims 1 and 30, independent claims 1 and 30 are believed to be patentably distinguishable over the combination of Contreras in view of Burris '993. Accordingly, the rejection is again traversed, and Applicants respectfully submit that independent claims 1 and 30 are in condition for allowance, as are all claims dependent from claim 1.

For purposes of brevity, Applicants do not specifically address the limitations of each of the dependent claims, but respectfully urge them to be patentable for the reasons set forth relative to claims 1 and 30. Applicants reserve the right to submit further arguments in support of the dependent claims in a subsequent communication or on appeal.

However, Applicants do wish to note for the record that specific rejections of the following list of dependent claims, allegedly included in this rejection, are not believed to be set forth in the final office action of March 2009 or in the preceding office action: claims 3, 7-11, 18, 20-22, 25,[2] 26 and 33-34. As such, the office action is either incomplete, incorrect (claims listed as rejected are not actually rejected), or the noted claims are in condition for allowance. In the event the listed dependent claims are rejected, and an indication of the basis for such rejections is set forth, Applicants respectfully reserve the right to further amend or address the dependent claims in response to a *prima facie* showing of obviousness.

With respect to the rejection of dependent claim 31,[3] it appears the Examiner misconstrued the limitation as a control system that permits the device to be turned off. Such an operation may be accomplished via a switch. Applicants seek to clarify the limitation in the amendment proposed for claim 31, wherein the control system itself, in response to a period of non-use, automatically turns the system off. Such an operation is consistent with the disclosure found at ¶0021 of the published application, and Applicants respectfully urge that claim 31 is now in condition for allowance.

[2] Claims 20 and 25 were discussed in the Sept. 2009 office action, but are not mentioned in the final office action.
[3] Rejection seems to be addressed in arguments in response to Applicants as found at p. 4 of the office action.

Claim 1 was rejected under 35 USC §103(a) as being unpatentable over Burris '993 in view Contreras. With respect to the rejection of claim 1, Applicants again respectfully urge that the amended independent claim, as described above, is patentably distinguishable over any combination of Burris '993 and Contreras. For purposes of brevity, Applicants have not re-asserted the arguments set forth in detail above, but instead incorporate them herein.

Moreover, in the rejection based upon Burris '993 in view of Contreras, the Examiner selectively picks from the description and thereby ignores the context in which the teachings are provided. For example, the examiner states at page 21 of the office action, describing the features of '993, "[a] circulation system, i.e., circulation loop, draws liquid from the reservoir 36 via line 16 through pumping system 20 (which is a pressure regulator) and returns purified liquid to the reservoir via line 41. Therefore, the circulation system re-circulates liquid containing dissolved ozone and is capable of continuous circulation (Col. 5 ll. 59-67)." However, following this text the '993 description reads, "[w]hen treatment is completed and outflow is desired, valve 44 changes state, preferably in response to an outflow switch so that liquid flows directly to an outlet from pump 43. Generator 15 is preferably turned off while this occurs." Applicants once again respectfully contend that the context of Burris '993 clearly indicates that the invention of Burris '993 is a batch unit and is distinct from a continuous re-circulation device as presently recited in the rejected claim.

Claims 1-3, 5, 7-16, 18, 20-29, 31 and 33-34 were rejected under 35 USC §103(a) as being unpatentable over Engelhard et al., US 5,942,125 ("Engelhard") in view of Burris '993. Applicants continue to urge that the suggested combination fails to support all the limitations recited in claim 1. Among other limitations, Applicants respectfully submit that neither Engelhard nor Burris '993, alone or in combination, teach a control system and an ozone sensor, located in said liquid circulation passageway. Accordingly, claim 1 is urged to be patentably distinguishable over the combination of Engelhard in view of Burris '993, and the rejection is respectfully traversed. Applicants believe amended independent claim 1 is in condition for allowance, as are rejected claims 2-3, 5, 7-14, 16-18, 20-29 and 31, dependent therefrom.

For purposes of brevity additional arguments relative to the dependent claims are reserved for a subsequent response or on appeal. However, with respect to the

rejection of dependent claim 31, Applicants respectfully contend that the Examiner has improperly characterized the teachings of Engelhard, particularly relative to a control system. Col. 3, lines 57-63 do not appear to teach "a control system wherein the control system, in response to a period of non-use, turns the device off." Applicants seek to clarify this by amendment proposed for claim 31. Accordingly, the rejection of dependent claim 31 is again traversed.

With respect to dependent claims 2-3, 7, 10-12, 15, 18, 20-22, 24-26 and 33-34, as similarly noted relative to the first rejection discussed above, no particular rejection has been set forth relative to these claims. Hence, *prima facie* obviousness has not been established for the claims to which Applicants can or must respond. Hence the finality of the rejection is premature, at best, or the listed dependent claims are allowable.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

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